

III. Remarks

A. Status of the Application

Claims 1-20 are pending. Claims 8-17 are withdrawn as being directed to an unelected invention. No claims are presently added or canceled. Reconsideration of claim 1-7 and 18-20 in light of the following remarks is respectfully requested.

B. Claim Rejections – 35 U.S.C. §102

Claims 1, 4-7, and 18-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,772,195 to Hatlelid et al. (“the Hatlelid patent”). This rejection is respectfully traversed for the following reasons.

The PTO provides in MPEP § 2131 that

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). … “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

Therefore, to sustain the rejection of claims 1, 4-7, and 18-20 the Hatlelid patent must disclose each and every element in as complete detail as recited in the claims.

With respect to amended independent claim 1, however, the Hatlelid patent at least fails to disclose “determining a maximum number of simultaneous connections N supportable by a client.” The Hatlelid patent “relates generally to virtual world applications, and more specifically, to controlling the behavior of avatars within the virtual world” to provide “a more realistic environment for users communicating within [the] virtual world.” Col. 1, ll. 7 – Col. 2, ll. 4. In that regard, the Hatlelid patent disclosing moving avatars around in the virtual world so that “the avatars appear to be naturally displayed as groups of people having conversations with each other.” Col. 2, ll. 40-43. The Hatlelid patent simply does not discuss or disclose determining the maximum number of simultaneous connections supportable by a client as required by claim 1. The Hatlelid patent appears to be completely unconcerned with the number of simultaneous connections supportable by a client. For example, the Hatlelid patent notes that “[t]here is no logical limit to the number of avatars 108 that can be placed in a chat cluster 104.”

Further, Applicants would point out that the Office Action's indication that the Hatlelid patent "discloses multiple number of connections in a chat cluster" clearly cannot be equated to the claim limitation requiring "determining a maximum number of simultaneous connections N supportable by a client." Having multiple participants in a chat cluster simply is not the same as determining the maximum number of simultaneous connections supportable by a client. Accordingly, for at least these reasons the Hatlelid patent fails to disclose each and every element in as complete detail as recited in independent claim 1.

Claims 4-7 depend from and further limit claim 1. Accordingly, the Hatlelid patent fails to disclose each and every element in as complete detail as recited in claims 4-7 for at least the same reasons. Further, claims 4-7 recite additional limitations not disclosed by the Hatlelid patent. For example, claim 6 recites "wherein the predefined criterion is distance based." The Hatlelid patent clearly does not disclose such a limitation. The Office Action asserts "(see col. 7, lines 37-57, Hatlelid discloses a predefined distance based criteria that is required to join a chat session or cluster." However, it is clear from the description of the Hatlelid patent at col. 7, lines 37-57 that there is no distance requirement for joining a chat cluster. Instead, the Hatlelid patent clearly notes that the conversation area in the virtual world may be expanded to accommodate additional participants in the chat in accordance with the Hatlelid patent's goal of providing a more realistic environment for users communicating in the virtual world. The decision of whether to allow a participant to join a chat cluster is simply not based on distance. Accordingly, for at least this additional reason the Hatlelid patent fails to disclose each and every element in as complete detail as recited in claim 6.

As another example, claim 7 recites "determining whether the client has received permission from each of the identified entities to communicate with each entity; and if permission has not been received from one of the identified entities, identifying between one and N entities that meet the predefined criterion, wherein the identifying excludes the previously identified entity from which permission has not been received." The Hatlelid patent clearly does not disclose such a limitation. The Office Action cites generally to col. 5, ll. 12-28 and col. 7, ll. 1-37 as disclosing such limitations. However, these portions of the Hatlelid patent simply do not appear to disclose such limitations. Applicants see no disclosure in the Hatlelid patent of determining whether a client has received permission from an identified entity to communicate with that entity, and then identifying entities that meet a predefined criteria but excluding any

entities for which permission has not been received. Accordingly, for at least this additional reason the Hatlelid patent fails to disclose each and every element in as complete detail as recited in claim 7.

For at least these reasons, Applicants request that the §102 rejection of claims 1 and 4-7 over the Hatlelid patent be withdrawn.

With respect to independent claim 18, the Hatlelid patent at least fails to disclose “determining a maximum number of simultaneous connections N supportable by the client computer.” As discussed in greater detail above with respect to independent claim 1, the Hatlelid patent simply does not disclose such a limitation. Accordingly, for at least the same reasons the Hatlelid patent fails to disclose each and every element in as complete detail as recited in independent claim 18.

Further, the Hatlelid patent also fails to disclose “sending a permission message from the client computer to each of the identified entities, wherein the permission message indicates that the entity can establish a communication channel with the client computer; and sending a revocation message from the client computer to each of the entities that are not among the identified entities, wherein the revocation message indicates that the entity can no longer communicate with the client computer.” In that regard, the Hatlelid patent simply does not disclose sending a revocation message indicating that an entity can no longer communicate with the client computer, as recited. While the Hatlelid patent discloses having private chat clusters, the Hatlelid patent does not disclose sending out a revocation message to all of the other participants in the virtual world when the private chat cluster is created. Further, simply because a participant is in a private chat cluster does not mean that any one outside of the private chat cluster can no longer communicate with the participant. Accordingly, for at least this additional reason the Hatlelid patent fails to disclose each and every element in as complete detail as recited in independent claim 18.

Claims 19 and 20 depend from and further limit independent claim 18. Accordingly, the Hatlelid patent fails to disclose each and every element in as complete detail as recited in claims 18 and 19 for at least the same reasons. Further, claims 18 and 19 recite additional limitations not disclosed by the Hatlelid patent. For example, claim 19 recites “determining whether the client computer has received permission from each of the identified entities to communicate with each entity; and if permission has not been received from one of the identified entities,

identifying between one and N entities that meet the predefined criterion, wherein the identifying excludes the previously identified entity from which permission has not been received.” As discussed in greater detail above with respect to claim 7, the Hatlelid patent simply does not disclose such a limitation. Accordingly, for at least this additional reason the Hatlelid patent fails to disclose each and every element in as complete detail as recited in claim 19.

Claim 20 recites “maintaining a permission table on the client computer, wherein the permission table associates each identified entity with a first indicator representing whether a permission message has been sent by the client computer and a second indicator representing that a permission message has been received by the client computer.” The Office Action asserts that the Hatlelid patent discloses such limitations at Col. 7, lines 1-17. However, this portion of the Hatlelid patent does not even mention a permission table, let alone one having the first and second indicators as recited. Accordingly, for at least this additional reason the Hatlelid patent fails to disclose each and every element in as complete detail as recited in claim 20.

For at least these reasons, Applicants request that the §102 rejection of claims 18-20 over the Hatlelid patent be withdrawn.

C. Claim Rejections – 35 U.S.C. §103

Claims 2 and 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of the Hatlelid patent and U.S. Patent No. 6,925,495 to Hegde et al. (“the Hegde patent”).

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

In the present application, a prima facie case of obviousness does not exist for claims 26 and 29 for at least the reasons set forth below.

35 U.S.C. §103(a) provides, in part, that:

“A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art . . .”
(emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Claims 2 and 3 depend from and further limit independent claim 1. However, as shown above the Hatlelid patent does not disclose all of the elements in as complete detail as recited in claim 1. The Hegde patent does not affect this deficiency. Accordingly, for at least the same reasons even when combined the Hatlelid and Hegde patents fail to disclose all of the elements of in as complete detail as recited in claims 2 and 3. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 2 and 3. Therefore, Applicants request that the §103 rejection of claims 2 and 3 over the Hatlelid and Hegde patents be withdrawn.

IV. Conclusion

It is believed that all matters set forth in the Office Action have been addressed and that all of the pending claims are in condition for allowance. An early indication of allowance is respectfully requested.

Should the Examiner deem that an interview with Applicant's undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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